



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/154,562	11/19/93	FOGEL	A 90038B

12M2/0728  
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EXAMINER
BARTS, S

ART UNIT	PAPER NUMBER
1204	

DATE MAILED: 07/28/97

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/154,562**

Applicant(s)

**Fogel**

Examiner

**SAMUEL BARTS**

Group Art Unit

**1204**



☒ Responsive to communication(s) filed on Dec 9, 1996

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 33-48 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 33-48 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

***Response to Arguments***

1. Applicant's arguments with respect to claims 33-48 have been considered but are moot in view of the new ground(s) of rejection.

In applicant arguments it was pointed out that the novelty of the claimed invention was the use of C<sub>12</sub> - C<sub>15</sub> fumarate esters in cosmetic compositions since they melt at body temperature. These esters were found in the prior art and hence a new ground of rejection was required.

***Claim Objections***

2. Claims 34, 36, 38, 40, 42, 44, 46, and 48 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In the independent claims R is defined as ..."*is a C<sub>11</sub> - C<sub>14</sub> blend straight chain alkyl group*". In each dependent claim the preferred substituent is isocetyl. **Isocetyl is a branched C<sub>16</sub> group. This branched C<sub>16</sub> group is broader than the range defined in the independent claims. Therefore, these claims fail to further limit said independent claims.**

Art Unit:

3. ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.


5. Claims 33-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amaya(Chem Abstract 113:178040c).

Amaya teaches the use of unsaturated polycarboxylic acid alkyl esters wherein the ester groups are equal to or greater than ten carbons. Amaya teaches specific and structurally similar compounds which read on the fumarates used in the instant claimed invention.(See highlighted portion of the printout). In addition, Amaya teaches said compounds for use in cosmetic compositions which ***“show good compatibility with the skin”***. Amaya fails to teach his compositions for the instantly claimed cosmetic preparations.

It would have been obvious to one having ordinary skill in the art at the time that applicant's invention was made to have used the compositions of Amaya in cosmetics which were applied to the skin. Such a modification would have been obvious since a skilled artisan would be motivated to add the compositions of Amaya to other well known cosmetics which were applied to the skin because of the good skin compatibility properties of the said compositions.

Art Unit:

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Samuel Barts whose telephone number is (703)308-4630. The examiner's normal tour of duty is between 6:30-3:00, M-F. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1200 receptionist whose telephone number is (703) 308-1235. Communications may now be transmitted via FAX directly to group 1200. The official group 1200 FAX machine number is (703) 308-4556.

  
SAMUEL BARTS  
PATENT EXAMINER  
GROUP 1200

S.B.  
July 14, 1997  
Fax (703)308-4556